UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,926	08/08/2001	Amir Said	10018297-1	3679

7590 09/15/2005	EXAMINER
HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400	FERRIS III, FRED O

ART UNIT	PAPER NUMBER
2128	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>30 August 2005</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

    a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

    b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

       Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

    (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

    (b)☐ They raise the issue of new matter (see NOTE below);

    (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

       NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: _____.

    Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.
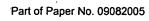
<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants arguments regarding the final office action are not persuasive for the following reasons:
1. Arguments offer piecemeal analysis of rejection: Examiner has not asserted that Henderson teaches image compression as indicated in note (1), page 6 of applicants response. Golin teaches image compression and randomly selecting pixels (Final Office Action, page 4, line 5). Examiner has not asserted that Golin teaches identifying predominate colors or testing colors in a digital image as asserted by applicants. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner has interpreted the claimed limitations to be obvious in view of the combined prior art teachings relating to testing for the occurrence of key colors in a color occurrence list disclosed by Henderson (CL8-L34-61, CL9-L10, Figs. 3, 6), and randomly selecting image pixels disclosed by Golin (CL27-L37-41, Fig. 42).

2. Arguments relate to features that are not claimed: Features relating to identifying a predominate color in the "foreground object" and "identifying background colors" that occur most often have note been specifically claimed. In this case, applicants arguments are more specific than the claims require. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. Argument that office action contains legal errors mischaracterizes the examiners rejection: No claim limitations have been ignored. a) Claims 7-10 and 19-22 recite creating a color list that includes initializing, incrementing, and testing a counter. The examiner has interpreted these limitations to be obvious in view of the prior art teachings relating to testing for the occurrence of key colors in a color occurrence list disclosed by Henderson (CL8-L34-61, CL9-L10, Figs. 3, 6), and randomly selecting image pixels disclosed by Golin (CL27-L37-41, Fig. 42). Obviously, a skilled artisan would have implemented the color occurrence list by initializing, incrementing, and testing a counter in "processing" the color occurrence "list" (i.e. "list processing", See: Microsoft Computer Dictionary, 1997) Further, it is well established that any computer register, memory location, or computer program can be implemented to act a "counter" that can be initialized, incremented, and tested during list processing (See: "counter" Microsoft Computer Dictionary, 1997). There is therefore no "technical error" relating to the counter as alleged by applicants.
b) The limitation relating to "reducing the probability of a false-positive/negative outcome" has not been ignored and is specifically addressed in the final office action on page 3, lines 11-21. As cited in the final action, the examiner has interpreted this limitation as equivalent to identifying predominated from randomly selected pixels in a color occurrence list and is hence obvious in view of the color occurrence list disclosed by the combination of Henderson and Golin. The examiner has therefore clearly interpreted the "meaning" of applicants claimed subject matter, and not simply "interpreted" the prior art as alleged by applicants. These limitations have been interpreted by the examiner to functionally equivalent to the teachings of the combination of Henderson and Golin as noted above and in the final office action. MPEP 2106 recites the following supporting rational for this interpretation:
"While it is appropriate to use the specification to determine what applicant intends a term to mean, a positive limitation from the specification cannot be read into a claim that does not impose that limitation. A broad interpretation of a claim by Office personnel will reduce the possibility that the claim, when issued, will be interpreted more broadly than is justified or intended. An applicant can always amend a claim during prosecution to better reflect the intended scope of the claim."

4) The examiner maintains that the motivation to combine Henderson and Golin is proper and in accordance with MPEP guidelines for the following reasons. MPEP 2143.01 Suggestion or Motivation To Modify the References first recites:
"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)

In this case the examiners rejection first addresses the nature of the problem to be solved, namely, identifying colors in a digital image by applying a detection rule to randomly selected pixels, relative to the teachings in the prior art. More specifically, that a skilled artisan would have made an effort to become aware of what capabilities had been developed in the market place, and hence would have knowingly modified Henderson with the teachings of Golin. (See: final office action page 4, paragraph 2) MPEP 2144 Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103 recites:
"The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); In re Eli Lilly & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings)"

The examiner has simply asserted that a skilled artisan tasked with solving the problem of testing for the occurrence of key colors in a color occurrence list (i.e. as taught by Henderson), including randomly selecting image pixels (i.e. as taught by Golin), and further having access to the teachings of Henderson and Golin, would have   knowingly modified the teachings of Henderson, with the teachings

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of Golin in order to gain the advantage of reduced cost and development time. Specifically, a skilled artisan working in this obviously competitive environment would have made an effort to become aware of what capabilities had already been developed in the market place, and hence would have been aware of, and known to seek out the relative teachings of the problem to be solved. Namely, the teachings of Henderson and Golin.

MPEP 2143.01 Suggestion or Motivation To Modify the References further recites the following supporting rational:
"Obviousness can only be established by combining or modifying the teachings of the prior
art to produce the claimed invention where there is some teaching, suggestion, or
motivation to do so found either explicitly or implicitly in the references themselves or in
the knowledge generally available to one of ordinary skill in the art. "The test for an
implicit showing is what the combined teachings, knowledge of one of ordinary skill in the
art, and the nature of the problem to be solved as a whole would have suggested to those
of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317
(Fed. Cir. 2000)."

The examiner therefore appears to have established an implicit showing that in view of the combined teachings of the prior art, the relative knowledge of one skilled in the art, and in particular, the nature of the problem to be solved, there exists an obvious motivation to combine the references as noted above.